

Applicant: Miller et al.  
Serial No.: 10/805,838  
Filed: March 22, 2004  
Page 6 of 8

Remarks

Introduction

Claims 15-29 were pending. By way of this amendment, claims 15, 21, and 26 have been amended, and claims 30 and 31 have been added. Support for the amendments and new claims may be found in the specification as originally filed, and care has been taken to avoid adding new matter. Accordingly, claims 15-31 are currently pending.

Rejections Under 35 U.S.C. § 112, second paragraph

Claims 15-25 have been rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite. In particular, the Office Action indicates that claim 15 is indefinite because X is not defined, and because it is allegedly unclear since the method does not provide any specific binding partner. The Office Action indicates that claims 16-20 lack antecedent basis for the terms "enzyme", "antibody", and "pH". The Office Action indicates that claim 21 is allegedly indefinite since it is allegedly not clear how the "measuring" step is performed.

Applicant does not concede to the correctness of the rejections. However, to advance the prosecution of the above-identified application, claims 15, 21, and 26 have been amended as set forth above. Claims 15 and 26 have been amended to define X. Claim 15 has also been amended to make more clear that the binding site is a portion of an antibody-bound analyte. Claim 21 has been amended to make more clear that the measuring is performed to determine the concentration of the compound. One such method includes measuring a chemiluminescent signal, as recited in claim 22. Other methods of measuring can include measuring signals produced by the presence of the compound.

As to the antecedence basis of claims 16-20, Applicant traverses the rejection. Claim 16 recites "an" enzyme, not "the" enzyme. Thus, claim 16 is the first occurrence of "enzyme" used in the method of claim 15. Similarly, claim 18 recites "an" antibody, not "the" antibody. Thus, claim 18 is the first occurrence of "antibody" used in the method of claim 16. Similarly, claim 19

Applicant: Miller et al.  
Serial No.: 10/805,838  
Filed: March 22, 2004  
Page 7 of 8

recites "a" basic pH, and not "the" basic pH. Thus, claim 19 is the first occurrence of "basic pH". Accordingly, claims 16, 18, and 19 define the terms "enzyme", "antibody", and "basic pH" in the first instance, and provide the antecedent basis for any further dependent claim.

In view of the above, Applicant submits that the claims satisfy the requirements of 35 U.S.C. § 112, second paragraph, and respectfully requests that the rejection of the present claims based on this statutory provision be withdrawn.

Obviousness-type Double Patenting

Claims 26-29 have been rejected under the judicially created doctrine of obviousness-type double patenting over the parent application (U.S. Pat. No. 6,723,851).

Enclosed herewith is a Terminal Disclaimer to overcome the obviousness-type double patenting rejection.

Request for Interview

To the extent that all of the outstanding rejections have not been overcome, the undersigned respectfully requests the Examiner to call him to discuss the outstanding issues before mailing another Office Action.

Applicant: Miller et al.  
Serial No.: 10/805,838  
Filed: March 22, 2004  
Page 8 of 8

Conclusion

In conclusion, applicant submits that the rejections have been overcome and that the application is in condition for allowance. Therefore, Applicant respectfully requests the Examiner to allow the above-identified application at an early date. If a phone call would facilitate examination of this application, applicant requests the Examiner to call the undersigned at the number below.

Respectfully submitted,

Date: July 5, 2005

/Greg S. Hollrigel, Reg. # 45374/  
Greg S. Hollrigel  
Stout, Uxa, Buyan & Mullins, LLP  
4 Venture, Suite 300  
Irvine, California 92618  
Telephone: 949-450-1750